



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,521	09/30/2003	Mark R. Player	038073-5002 US	1436

9629 7590 04/05/2006
MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

EXAMINER

BALASUBRAMANIAN, VENKATARAMAN

ART UNIT PAPER NUMBER

1624

DATE MAILED: 04/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/673,521	Applicant(s) PLAYER ET AL.	
	Examiner Venkataraman Balasubramanian	Art Unit 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicants' response, which included amendment to claims 6, 7, 20-22 and 31-42, filed on 1/6/2006, is made of record.

Claims 1-44 are pending.

In view of applicants' response, the following rejections made in the previous office action are maintained.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-44 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for making pharmaceutically acceptable salts does not reasonably provide enablement for making hydrate. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims for reasons of record. To repeat: The following apply. Any claim not specifically rejected is rejected as it is a dependent claim and shares the same lack of scope of enablement.

In evaluating the enablement question, several factors are to be considered. Note *In re Wands*, 8 USPQ2d 1400 and *Ex parte Forman*, 230 USPQ 546. The factors include: 1) The nature of the invention, 2) the state of the prior art, 3) the predictability or lack thereof in the art, 4) the amount of direction or guidance present, 5) the presence

Art Unit: 1624

or absence of working examples, 6) the breadth of the claims, and 7) the quantity of experimentation needed.

1. The nature of the invention and the state of the prior art:

The invention is drawn to compound of formula I, II, III, IV or a pharmaceutically acceptable salt or solvate or hydrate thereof. Specification is not adequately enabled as to how to make solvate or hydrate of compounds of formula (I) Specification has no example of hydrate of the instant compounds. Specification recites solvate and hydrate thereof but there is no enabling of such compounds.

The compound of formula I, II, III, IV embrace 2-substituted- 4,6 diaminosubstituted triazine compounds substituted with variable groups R, R₁, R₂, R₃, A₁ and A₂.

Even a cursory calculation of the number of compounds embraced in the instant formula (I) based on the generic definition of alkyl., aryl, heteroaryl, heterocyclyl, substituted aryl, heteroaryl, arylalkyloxy, arylalkylamido etc would result in millions and millions of compounds. This is of course not the accurate number and the true number of compounds would far exceed this number of compounds. Thus the genus embraced in the claim 1 is too large and there is no teaching of any solvate or hydrate of this large genus.

Search in the pertinent art, including water as solvent resulted in a pertinent reference, which is indicative of unpredictability of hydrate formation in general. The state of the art is that is not predictable whether solvates or hydrates will form given a compound or what their composition will be. In the language of the physical chemist, a hydrate of organic molecule is an interstitial solid solution. This phrase is defined in the

Art Unit: 1624

second paragraph on page 358 of West (Solid State Chemistry). The solvent molecule is a species introduced into the crystal and no part of the organic host molecule is left out or replaced. In the first paragraph on page 365, West (Solid State Chemistry) says, "it is not usually possible to predict whether solid solutions will form, or if they do form what is the compositional extent". Thus, in the absence of experimentation one cannot predict if a particular solvent will solvate any particular crystal. One cannot predict the stoichiometry of the formed solvate, i.e. if one, two, or a half a molecule of solvent added per molecule of host. Compared with polymorphs, there is an additional degree of freedom to hydrates, which means a different solvent or even the moisture of the air that might change the stable region of the hydrate. In the instant case of hydrate a similar reasoning therefore apply. Water is a solvent and hence it is held that a pertinent detail of West, which relates to solvates, is also applicable to hydrate

In addition, an additional search resulted in Vippagunta et al., Advanced Drug Delivery Reviews 48: 3-26, 2001, which clearly states that formation of hydrates is unpredictable. See entire document especially page 18, right column section 3.4. Note Vippagunta et al., states "Each solid compound responds uniquely to the possible formation of solvates or hydrates and hence generalizations cannot be made for series of related compounds".

2. The predictability or lack thereof in the art:

Hence, the solvate or hydrate as applied to the above-mentioned compounds claimed by the applicant are not art-recognized compounds and hence there should be adequate enabling disclosure in the specification with working example(s).

3. The amount of direction or guidance present:

Examples illustrated in the experimental section are limited to making the compounds not related to hydrates. There is no example of solvate or hydrate of instant compound. Thirty-one compounds were shown in the examples of the specification each of which has come in contact with water and other solvent but there is no showing that instant compounds formed solvates or hydrates. Hence it is clear that merely bring the compound with water does not result in solvate or hydrate and additional direction or guidance is needed to make them. Specification has no such direction or guidance.

4. The presence or absence of working examples:

There is no working example of any solvate or hydrate formed. The claims are drawn to solvate and hydrate, yet the numerous examples presented all failed to produce a solvate or even a hydrate. Solvate or hydrate cannot be simply willed into existence. As was stated in *Morton International Inc. v. Cardinal Chemical Co.*, 28 USPQ2d 1190 "The specification purports to teach, with over fifty examples, the preparation of the claimed compounds with the required connectivity. However ... there, is no evidence that such compounds exist... the examples of the '881 patent do not produce the postulated compounds... there is ...' no evidence that such compounds even exist." The same circumstance appears to be true here. There is no evidence that hydrates of these compounds actually exist; if they did, they would have formed. Hence, there should be showing supporting that solvates and hydrates of these compounds exist and therefore can be made.

5. The breadth of the claims & the quantity of experimentation needed:

Art Unit: 1624

Specication has no support, as noted above, for compounds generically embraced in the claim 1 would lead to desired solvate and hydrate of the compound of formula I. As noted above, the genus embraces over million compounds and hence the breadth of the claim is broad. The quantity of experimentation needed would be an undue burden on skilled art in the chemical art since there is inadequate guidance given to the skilled artisan for the many reasons stated above. Even with the undue burden of experimentation, there is no guarantee that one would get the product of desired solvate and hydrate of compound of formula I-IV embraced in the instant claims in view of the pertinent reference teachings.

MPEP 2164.01(a) states, "A conclusion of lack of enablement means that, based on the evidence regarding each of the above factors, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. In re Wright, 999 F.2d 1557,1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)." That conclusion is clearly justified here. Thus, undue experimentation will be required to make Applicants' invention.

This rejection is same as made in the previous office action. Applicants' traversal to overcome this rejection is not persuasive.

First of all, applicants have no shown that instant compounds for hydrate or solvate. There are no examples in the specification even though during the process of making these compounds had contact with water and solvent.

Art Unit: 1624

Secondly, applicants' argument that West does not relate solvate or hydrate is incorrect. The fact that West discusses physical chemistry of solvate is also not relevant. West is clearly indicative that solvate and hydrate formation is not predictable.

The same is true with Vippagunta et al., which also shows unpredictability of solvate or hydrate formation. The fact that 35 % of pharmaceutical compounds form hydrate, is not an objective enablement for instant compounds. The issue is not whether pharmaceuticals form hydrates. The issue is whether instant compounds form hydrate and whether such hydrate formation is predictable.

For want of any showing that instant compounds form solvate or hydrate, this rejection is deemed as proper and is maintained.

Claims 17-42 are rejected under U.S.C. 112, first paragraph, because the specification while being enabling for treating breast cancer, does not reasonably provide enablement for inhibition of any or all tyrosine kinase, treating any or all cancer, any or all vascular disease, any or all ocular disease. The specification does not enable any physician skilled in the art of medicine, to use the invention commensurate in scope with these claims for reasons of record. To repeat:

The instant claims are drawn as reach through claims wherein based on the mode of action, it is recited that any or all diseases/disorders can be treated. In the instant case, based on the mode of action of instant compounds as tyrosine kinase inhibitor based on limited assay with limited enzyme, it is claimed that any or all cancer, any or all vascular disease, any or all ocular disease can be treated in general. The scope of the claims includes any or all cancer or any or all vascular and ocular diseases due to tyrosine

Art Unit: 1624

kinase inhibition including those yet to be discovered as due said mode of action for which there is no enabling disclosure. In addition, the scope of these claims includes treatment of various diseases, which is not adequately enabled solely based on the activity of the compounds provided in the specification at pages 42-43. The instant compounds are disclosed to have tyrosine kinase inhibitory activity (VEGF kinase) and it is recited that the instant compounds are therefore useful in treating any or all diseases stated above for which applicants provide no competent evidence. It appears that the applicants are asserting that the embraced compounds because of their mode of action as kinase inhibitor that would be useful for all sorts of proliferative diseases and cancers, vascular diseases, any ocular disease which involve tyrosine kinase pathway. However, the applicants have not provided any competent evidence that the instantly disclosed tests are highly predictive for all the uses disclosed and embraced by the claim language for the intended host. Moreover many if not most of diseases such as psoriasis and cancers, vascular diseases are very difficult to treat and despite the fact that there are many drugs, which can be used for "inhibiting tyrosine kinases".

The scope of the claims involves all of millions and millions of compounds of claims 1-7 as well as the thousand of diseases embraced by the terms cancer, vascular and ocular diseases.

Proliferative disease would include benign tumors, malignant tumors, polyps, lumps, lesions, other pre-cancerous conditions, psoriasis, leukemia, the hyper proliferation of the gastric epithelium caused by the *Helicobacter pylori* infection of ulcers.

Cancer is just an umbrella term. Tumors vary from those so benign that they are never treated to those so virulent that all present therapy is useless. .

No compound has ever been found to treat cancers of all types generally. Since this assertion is contrary to what is known in medicine, proof must be provided that this revolutionary assertion has merits. The existence of such a “compound” is contrary to our present understanding of oncology. Cecil Textbook of Medicine states, “each specific type has unique biologic and clinical features that must be appreciated for proper diagnosis, treatment and study” (see the enclosed article, page 1004). Different types of cancers affect different organs and have different methods of growth and harm to the body. Thus, it is beyond the skill of oncologists today to get an agent to be effective against cancers generally. Note substantiation of utility and its scope is required when utility is “speculative”, “sufficiently unusual” or not provided. See *Ex parte Jovanovics*, 211 USPQ 907, 909; *In re Langer* 183 USPQ 288. Also note *Hoffman v. Klaus* 9 USPQ 2d 1657 and *Ex parte Powers* 220 USPQ 925 regarding type of testing needed to support in vivo uses.

Next, applicant's attention is drawn to the Revised Interim Utility and Written Description Guidelines, at 66 FR 1092-1099, 2001, wherein it is emphasized that ‘a claimed invention must have a specific and substantial utility’. The disclosure in the instant case is not sufficient to enable the instantly claimed method treating solely based on the inhibitory activity disclosed for the compounds. The state of the art is indicative of the requirement for undue experimentation. See Hasan et al. Expert Opin.

Art Unit: 1624

Biol. Ther. 1(4): 703-718, 2001 and Pegram et al. Semin. Oncol. 29(3) Suppl11) 29-37, 2002.

In evaluating the enablement question, several factors are to be considered. Note *In re Wands*, 8 USPQ2d 1400 and *Ex parte Forman*, 230 USPQ 546. The factors include: 1) The nature of the invention, 2) the state of the prior art, 3) the predictability or lack thereof in the art, 4) the amount of direction or guidance present, 5) the presence or absence of working examples, 6) the breadth of the claims, and 7) the quantity of experimentation needed.

1) The nature of the invention: Therapeutic use of the compounds in treating disorders/diseases that require tyrosine kinase inhibitory activity.

2) The state of the prior art: Recent publications expressed that the tyrosine kinase inhibition effects are unpredictable and are still exploratory. See references cited above.

3) The predictability or lack thereof in the art: Applicants have not provided any competent evidence or disclosed tests that are highly predictive for the pharmaceutical use for treating any or all condition of the instant compounds. Pharmacological activity in general is a very unpredictable area. Note that in cases involving physiological activity such as the instant case, "the scope of enablement obviously varies inversely with the degree of unpredictability of the factors involved". See *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970).

4) The amount of direction or guidance present and 5) the presence or absence of working examples: Specification has no working examples to show treating any or all

Art Unit: 1624

condition and the state of the art is that the effects of tyrosine kinase inhibitors are unpredictable.

6) The breadth of the claims: The instant claims embrace any or all vascular, ocular diseases and cancers including those yet to be related to tyrosine kinase.

7) The quantity of experimentation needed would be an undue burden to one skilled in the pharmaceutical arts since there is inadequate guidance given to the skilled artisan, regarding the pharmaceutical use, for the reasons stated above.

Thus, factors such as “sufficient working examples”, “the level of skill in the art” and “predictability”, etc. have been demonstrated to be sufficiently lacking in the instant case for the instant method claims. In view of the breadth of the claims, the chemical nature of the invention, the unpredictability of enzyme-inhibitor interactions in general, and the lack of working examples regarding the activity of the claimed compounds towards treating the variety of diseases of the instant claims, one having ordinary skill in the art would have to undergo an undue amount of experimentation to use the instantly claimed invention commensurate in scope with the claims.

MPEP §2164.01(a) states, “A conclusion of lack of enablement means that, based on the evidence regarding each of the above factors, the specification, at the time the application was ‘filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. In re Wright, 999 F.2d 1557,1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993).” That conclusion is clearly justified here and undue experimentation will be required to practice Applicants’ invention.

This rejection is same as made in the previous office action.

Applicants' response to overcome this rejection is not persuasive.

First of all, instant claims, as recited, are reach through claims. A reach through claim is a claim drawn to a mechanistic, receptor binding or enzymatic functionality in general format and thereby reach through a scope of invention for which they lack adequate written description and enabling disclosure in the specification.

In the instant case, based on the inhibition of protein tyrosine kinase by the instant compounds, instant claims reaches through inhibiting and treating any or all cancers in general and thereby they lack adequate written description and enabling disclosure in the specification.

More specifically, claims 26-44, in the instant case, based on the mode of action of instant compounds as inhibitor of KDR kinase, based on limited assay, it is claimed that inhibiting any or all kinases and treating any or all cancers in general, which there is no enabling disclosure. Similarly claims 17-19 and 23-25, based on the mode of action implicitly embrace treating any or all cancer as evident for instant specification.

Applicants have not provided any evidence or shown support for treating any or all cancer.

Claims 20-22 relate in vitro inhibition of any or all protein tyrosine kinases for which there is no enabling disclosure.

Hence, based on all the above considerations, this rejection is deemed as proper and is maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (571) 272-0662. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is James O. Wilson, whose telephone number is 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAG. Status

Art Unit: 1624

information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-2 17-9197 (toll-free).


Venkataraman Balasubramanian

4/1/2006